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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,812	10/05/2001	Thomas Clement Barthel	CMS-012	6757

7590 12/02/2002

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EXAMINER

RAM, JOCELYN DEBRA

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,812

Applicant(s)

BARTHEL ET AL.

Examiner

Jocelyn D Ram

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: 28 (page 8); and the drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "38" has been used to designate both proximal end and distal end (page 8). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, ~~7~~ 12, ~~18~~ and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Koyata (4,349,032). Koyata shows an elongate viewing assembly for use as part of an endoscope, comprising: a flexible main portion (3) bendable between a relaxed configuration and a strained configuration and carrying an imaging optical

fiber (15) and an illumination optical fiber (col 2, lines 63-66); and a rigid distal portion (5) connected to the main portion and having a distal end that is offset laterally from the main portion (5a) at an acute angle (Fig. 1), wherein the main portion and distal portion are made of different materials (inherently, since the main portion is flexible and the distal portion is made of rigid plastic), including an eyepiece (2).

Claims 1-3, 6, 8, 11, 12, 24 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hake (4,893,613). Hake shows an elongate viewing assembly for use as part of an endoscope, comprising: a flexible main portion (14b, 14c) bendable between a relaxed configuration and a strained configuration and carrying an imaging optical fiber and an illumination optical fiber (col 4, lines 3-7); and a distal portion (4a) connected to the main portion and having a distal end that is offset laterally from the main portion, as broadly as claimed (col 4, lines 27-30), wherein the distal portion is substantially rigid (col 4, lines 66-68), the main portion and distal portion are made of substantially similar materials, inherently including a handle, a light source, and an eyepiece (col 4, lines 7-11).

Claims 1-3, 5, 8, 9, 11, 12, 37, 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Salerno (5,394,865). Salerno shows an elongate viewing assembly for use as part of an endoscope, comprising: a flexible main portion (14) bendable between a relaxed configuration and a strained configuration (col 3, lines 50-63),

including a polymeric sheath (65), and carrying an imaging optical fiber (18) and an illumination optical fiber (22); and a distal portion connected to the main portion and having a distal end (16) that is offset laterally from the main portion (14), as broadly as claimed (Fig. 4), wherein the distal portion is substantially rigid (col 3, lines 63-68), and has a diameter in the range of 2-5 mm (col 3, lines 54-56 and 62-64), the main portion and distal portion are made of substantially similar materials, , wherein the distal portion has a distal tip (16) having a diameter greater than that of the distal portion (col 4, lines 57-60), further including a handle (12), a light source (32), and an eyepiece (60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10, 13-17 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyata. Koyata shows all of the limitations of claims 4, 13-17, 19-23, 25-31, 33-36 except for the specific offset angle, offset distance, and radius of curvature. Since the instant invention does not show criticality of a specific angle or distance, and the invention of Koyata is capable of bending by operating the string means, it would

have been obvious to one of ordinary skill in the art at the time of the invention to bend the flexible tube at any angle, radius and distance.

Regarding claim 10, Koyata discloses that the distal portion can be made of a rigid plastic. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an alternative material that has similar rigidity properties, such as a metal material. It is noted that the instant invention does not place any criticality on the composition of the material of the distal end except that it is rigid and suitable for use in surgery.

Claims 4, 13-17, 19-23, 25-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hake. Hake shows all of the limitations of claims 4, 13-17, 19-23, 25-31, 33-36 except for the specific offset angle, offset distance, and radius of curvature. Since the instant invention does not show criticality of a specific angle, distance, or radius of curvature, and the invention of Hake is capable of bending "in a desired direction," it would have been obvious to one of ordinary skill in the art at the time of the invention to bend the flexible tube at any angle, radius and distance.

Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salerno. Salerno shows a method of using a probe in an intubation procedure, comprising the steps of: providing an endoscope with an elongate light guide having a flexible main portion and a distal end that is laterally offset from the flexible portion

(col 5, lines 30-31); inserting the light guide into the mouth of the patient (col 5, lines 32-54) with the substantially rigid (col 3, lines 65-68) distal end offset in the direction of curvature; and advancing the light guide within the throat. Although Salerno teaches the placement of the endotracheal tube over the stylet, it would have been obvious to one of ordinary skill in the art at the time of the invention, that the stylet can also be inserted within an already placed intubation tube.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zukowski (3,677,262) shows a rigid endotracheal tube inserter with an offset distal end. Moriyama (6,203,494) shows a flexible endoscope capable of varying the hardness and curvature of sections. Ouchi (6,402,687) shows an endoscope with a rigid end and a flexible section. Bullard (5,318,008), Salerno (5,580,147), Ortiz et al. (5,346,504), Finn et al. (5,512,034), and Klostermeyer et al. (6,200,306) all show flexible tubes with bendable distal ends.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 9-5.

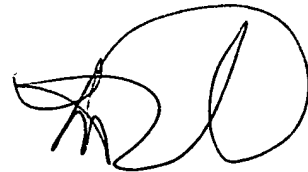
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9302

for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to be "LD", enclosed within a large, loopy oval shape.

**LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700**

JR
November 25, 2002